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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,054	10/03/2000	Albrecht Dorschner	Beiersdorf 656-KGB	4744

7590 04/29/2002

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NEW YORK, NY 10017

EXAMINER

LAMM, MARINA

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 04/29/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/679,054

Applicant(s)

DORSCHNER ET AL.

Examiner

Marina Lamm

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 February 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/20/02 has been entered.
2. Claims pending are 5-13.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 7, 8, 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 7 and 8 recite the limitation "O/W macroemulsions" in line 1. There is insufficient antecedent basis for this limitation in the claims because Claim 5, as amended, does not recite macroemulsions.

Claims 10 and 11 recite the limitation "in the finished cosmetic or dermatological preparations". There is insufficient antecedent basis for this limitation in the claims because Claim 5 does not recite cosmetic or dermatological preparations.

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 5-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Kaplan or McShane et al. or Hart et al. in view of Philippe et al. (US 6,255,332) and Hill et al. (US 5,730,967).

Kaplan teaches oil-in-water sunscreen compositions containing 0.05-20% of emulsifiers such as PEG-45/ dodecyl glycol copolymer, polyglyceryl-3-diisostearate, sorbitan trioleate, etc., and up to 15% of insect repellents such as DEET. See col. 1, line 50; col. 4, lines 36-65; col. 5, lines 25-29; col. 6, lines 42-62. The composition of Kaplan may contain 1-10% of glycerin or polymeric glycols. See col. 6, lines 5-12.

McShane et al. teach sunscreen oil-in-water emulsions containing 0.05-20% of at least one emulsifier (e.g. PEG-45/ dodecyl glycol copolymer, polyglyceryl-3-diisostearate, sorbitan trioleate, cetareth-15) and up to 15% of an insect repellent such as DEET. See Abstract; col. 5, lines 2-4, 29-60; col. 6, lines 4-8; col. 7, lines 31-53. The composition of McShane et al. may contain 1-10% of glycerin or other glycols. See col. 6, lines 52-58.

Hart et al. teach oil-in-water emulsions containing insect repellents, such as N,N-diethyl-m-toluamide, propylene glycol and nonionic emulsifiers such as polyoxyethylene stearate and oleate, polyethoxylated cetyl alcohol, mono-, di- and tri- esters of various polyols, glycerol monostearate, sorbitan tristearate and sorbitan dioleate, in the claimed concentrations. See Abstract; col. 3, lines 4, 23-30; col. 10, Example VI. Propylene glycol is a known functional equivalent of glycerin.

Applicant's functional language regarding the properties of the emulsifiers A would have been inherent to the emulsifiers disclosed in the references.

Neither reference teaches microemulsions of the instant claims. However, Philippe et al. teach that cosmetic/dermatological compositions can be formulated in any form suitable for topical application, e.g. as emulsions or microemulsions. See col. 3, lines 45-51. Further, Hill et al. teach that microemulsions show exceptional stability and rheological properties as compared to macroemulsions. See col. 2, lines 24-58.

Therefore, one of ordinary skill would have been motivated to formulate emulsions of either Kaplan or McShane et al. or Hart et al. as microemulsion as suggested by Philippe et al. and Hill et al. with the reasonable expectation of beneficial results such as improved stability, rheological properties and esthetic appeal of the compositions.

7. Claims 5-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. in view of Neumiller (US 5,145,604).

Thomas et al. teach oil-in-water microemulsions containing 0.1-20% of ethoxylated glycerol-based non-ionic surfactants, anionic surfactants and 0.5-20% of insect repellents such as DEET. See Abstract; col. 4, lines 1-7; col. 5, lines 33-34. Applicant's functional language regarding the properties of the emulsifiers A would have been inherent to the non-ionic emulsifiers disclosed in the references.

Thomas et al. do not teach glycerin of the instant claims.

However, it is known to employ polyhydroxy alcohols such as glycerin in cleaning compositions for improving stability of the dispersed phase in the continuous phase. See Neumiller at col. 3, lines 34-40; col. 4, line 26; col. 5, lines 60-65.

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to use glycerin of Neumiller in cleaning compositions of Thomas et al. for its art-recognized purpose.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

***Conclusion***

8. No claim is allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (703) 306-4541.

The examiner can normally be reached on Monday to Friday from 9 to 5.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

ml  
4/26/02

  
JOSE C. DEES  
SUPERVISORY PATENT EXAMINER  
1616